



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,924	10/27/2003	Justin Monk	020375-043700US	5090
20350 7590 11/28/2007 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			EXAMINER SHUMATE, PAUL W	
			ART UNIT 3693	PAPER NUMBER
			MAIL DATE 11/28/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/694,924

Applicant(s)

MONK, JUSTIN

Examiner

Paul Shumate

Art Unit

3694

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 10-19 and 26-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 20-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-33 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date See Continuation Sheet.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :22 February 2005 and 13 July 2007.

## **DETAILED ACTION**

### **Status of Claims**

1. This action is in reply to the Application filed on 10/27/2003. Claims 1-33 are currently pending. Claims 1-9 and 20-25 (Invention I) have been elected with traverse as per telephone interview with attorney Patrick Boucher on 11/20/2007. Claims 1-9 and 20-25 have been examined and claims 10-19 and 26-33 are withdrawn from consideration

### ***Election/Restrictions***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I. Claims 1-9 and 20-25, drawn to generating a combined stored-value and credit instrument.
  - II. Claim 10-19 and 26-33, drawn to providing information for a combined stored-value and credit instrument.
3. The inventions are distinct, each from the other because of the following reasons:
4. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination I has separate utility such as generating an actual stored-value and credit instrument. Subcombination II has separate utility such as providing information about a combined stored-value and credit instrument. See MPEP § 806.05(d).

5. The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

6. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

7. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

8. During a telephone conversation with Attorney Patrick Boucher on 11/20/2007 a provisional election was made with traverse to prosecute the invention of I, claims 1-9 and 20-25. Affirmation of this election must be made by applicant in replying to this Office action. Claims 10-19 and 26-33 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim(s) 1-4, 6-9, and 20-25 rejected under 35 U.S.C. 103(a) as being unpatentable over Todd, U.S. Patent Application No.: 2003/0061093 in view of Simpson, U.S. Patent No.: 6,070,153.

**Claim 1:**

Todd teaches maintaining user, account, and reward information in a financial reward system (see at least paragraph(s) 0016-0018) where rewards that can be based on credit card, debit card, or check transactions (see at least paragraph(s) 0061 and 0076) are recorded in a customer's reward record, which is an account of the specific customer's accumulated rewards amounts related to the account which funded the transaction (see at least paragraph(s) 0024 and 0028). Therefore Todd broadly teaches the following limitations:

- receiving credit-account parameters to be associated with the instrument; (see at least paragraph(s) 0016-0018 and 0032) In order to maintain user, account, and reward information, it would be inherent that the information would first have to be received.
- establishing a credit account associated with the instrument in accordance with the credit-account parameters; (see at least paragraph(s) 0016-0018, 0061, and 0076) In order to maintain user, account, and reward information or to conduct transactions funded by a financial account, it would be inherent that the account would have to first be established.
- receiving stored-value-account parameters to be associated with the instrument; (see at least paragraph(s) 0016-0018 and 0032) In order to maintain user, account, and reward information, it would be inherent that the information would first have to be received.
- establishing a stored-value account associated with the instrument in accordance with the stored-value-account parameters; (see at least paragraph(s) 0018 and 0028) In order to maintain reward record information or to accumulate value in a reward record it would be inherent that the reward record or reward account would have to first be established.
- linking the credit account and the stored-value account; (see at least paragraph(s) 0018 and 0032)

- and initiating issuance of the instrument to the customer substantially contemporaneously with linking the credit account and the stored-value account. (see at least paragraph(s) 0047, 0049, and 0061) In order for a customer to use a credit card, issued by a financial institution, to conduct financial transactions, it would be inherent that the credit card first be issued to the customer before such transactions could take place.

While Todd does broadly teach the limitations as shown above, Todd does not explicitly state that the linking of the credit and stored value accounts and initiating issuance of the instrument occur substantially contemporaneously. Simpson, however, teaches that "applicants would complete application documentation for both accounts and return them to the Issuing Company [and then] separate account records would be set up for the credit card accounts and corresponding Investment Accounts. These data bases would be linked by account numbers and cross-referenced in that fashion (see at least column 6 lines 23-28)." Simpson also teaches that "simultaneously with the credit facility application the cardholder/investor fills out an IRA Application and Custodial Agreement (see at least column 3 line 66 to column 4 line 1)." It would have been obvious at the time the invention was made to a person having ordinary skill in the art to combine the teachings of Todd and Simpson and to link the two accounts substantially contemporaneously with issuing the credit card to the user because these are the final steps in setting up the above stated system and it would increase efficiency to do these steps at about the same time.

**Claim 2:**

Simpson further teaches:

- initiating issuance of the instrument is performed after linking the credit account and the stored-value account. (see at least column 3 line 66 to column 4 line 1 and column 6 lines 23-28). Simpson teaches linking the two accounts during the application process. In order to issue the credit instrument to the customer, the application process would have to be completed and the application would have to have been approved. Therefore linking the two accounts happens before issuing the credit instrument to the customer.

**Claim 3:**

Simpson further teaches:

- the credit-account parameters include specification of a credit limit. (see at least column 4 lines 27-37)

**Claim 4:**

Todd further teaches:

- the stored-value-account parameters include specification of a limited set of one or more merchants at which the stored-value account may be used. (see at least paragraph(s) 0003)
- Todd teaches that it is old and well known to offer rewards points that can be redeemable for products or services. As an example, Todd discloses the use of offering frequent flier mile reward points. The use of frequent flier miles are limited at least to airlines or businesses that sell airline tickets, therefore Todd teaches specifying a limited set of merchants at which the stored-value account may be used.

**Claim 6:**

Todd further teaches:

- receiving a request to reload value into the stored value account, the request being supported by funds; (see at least paragraph(s) 0032, 0062, and 0082)
- and augmenting a value amount for the stored-value account in accordance with the request. (see at least paragraph(s) 0032, 0062, and 0082)

**Claim 7:**

Todd further teaches:

- loading value equal to a specified fraction of an amount of a credit transaction executed with the instrument into the stored-value account in response to execution of the credit transaction. (see at least paragraph(s) 0007, 0024, 0027, 0073, and 0082)

**Claim 8:**

Todd further teaches:



- generating a consolidated statement summarizing customer activity on the linked credit account and stored-value account. (see at least paragraph(s) 0046 and 0081)

**Claim 9:**

Todd further teaches:

- responding to a customer-service request relating to at least one of the linked credit account and stored-value account. (see at least paragraph(s) 0067-0068)

**Claims 20-25:**

Claim 20 is parallel with the limitations in claim 1, thus is rejected on the same basis.

Claim 21 is parallel with the limitations in claim 2, thus is rejected on the same basis.

Claim 22 is parallel with the limitations in claim 6, thus is rejected on the same basis.

Claim 23 is parallel with the limitations in claim 7, thus is rejected on the same basis.

Claim 24 is parallel with the limitations in claim 8, thus is rejected on the same basis.

Claim 25 is parallel with the limitations in claim 9, thus is rejected on the same basis.

11. Claim(s) 5 rejected under 35 U.S.C. 103(a) as being unpatentable over Todd in view of Simpson, further in view of Centura (<http://web.archive.org/web/19980211083417/www.centura.com/cashcards/travelsmart.html>).

**Claim 5:**

Todd and Simpson teach the limitations disclosed above, but they do not teach

- the stored-value-account parameters include specification of an initial value amount for the stored-value account.

Centura, however, teaches "the Centura TravelSmart Program awards one travel point for every dollar you spend with your card-points you can use on any airline! And your points add up fast. That's because we give you 1,000 points just for signing up." It would have been obvious at the time the invention was made to a person having ordinary skill in the art to incorporate the teachings of Centura and to offer an initial value in the associated stored-value account because this would encourage people

to accept that offer instead of another similar offer, from a competitor, that may not offer an initial value in the stored-value account.

#### Conclusion


12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

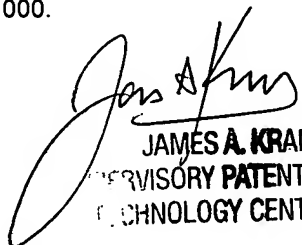
- US 5,297,026 by Hoffman drawn towards a system for promoting account activity
- US 5,787,404 by Fernandez-Holmann drawn towards a credi-card based retirement fund
- US 5,864,830 by Armetta et al. drawn towards satellite spending cards
- US 5,991,736 by Ferguson et al. drawn towards a patronage incentive award system
- US 6,076,075 by Teicher drawn towards an electronic wallet system
- US 6,330,978 by Molano et al. drawn towards an electronic purse card value system
- US 6,941,279 by Sullivan drawn towards a mutual fund card method and system

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Shumate whose telephone number is 571-270-1830. The examiner can normally be reached on M-F 8:30 AM - 6:00 PM, EST alt Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on 571-272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Name: Paul W. Shumate  
Title: Patent Examiner  
Date: 11/26/07  
Signature: 

 11.26.07  
JAMES A. KRAMER  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600